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Comments: Dale Thanks again for the help you gave on the phone concerning S.N. 08/931,615. We filed a petition with an attached Reply Brief last Friday in Box AF. Since the file is there at the Board and I believe assigned to a panel I thought I'd give you a heads up since the file will now have to be returned to the Tech Center. I have attached courtesy copies of what we filed and the stamped post card. Please call if you have any questions. My direct number is (202) 739-5812. Thanks, Beth

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PLEASE STAMP AND RETURN TO SHOW RECEIPT OF:

U.S. Patent Application of: Tomohiro KAWATA *et al.*
Application No.: 08/931,615
Filing Date: September 16, 1997
CPA Filed: May 24, 1999

Group Art Unit: 2743
Examiner: Huyen Le

For: SPEAKER UNIT

1. Petition under 37 C.F.R. 1.183 Requesting Entry of Appellant's Reply Brief in the Interest of Fairness and Justice
2. Appellants' Reply Brief under 37 C.F.R. 1.193(b)(1) (in triplicate)

The Commissioner is hereby authorized to charge Deposit Account No. 50-0310 in the amount of \$130.00 for the Petition fee.

Dated: January 31, 2003
Attorney Docket No.: 041464-5018-01
RJH/kya



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PATENT
ATTORNEY DOCKET NO.: 041464-5018-01

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:Tomohiro KAWATA *et al.*

Application No.: 08/931,615

Filed: September 16, 1997

CPA Filed: May 24, 1999

For: SPEAKER UNIT

Group Art Unit: 2743

Examiner: Huyen Le

Box AF - Expedited Procedure

Commissioner for Patents
Washington, D.C. 20231

Sir:

**PETITION UNDER 37 C.F.R. § 1.183 REQUESTING ENTRY OF APPELLANTS'
REPLY BRIEF IN THE INTEREST OF FAIRNESS AND JUSTICE**

Pursuant to 37 C.F.R. § 1.183, in the interest of fairness and justice, Appellants hereby respectfully petition the Commissioner to enter Appellants' Reply Brief, submitted herewith, in response to the Examiner's Answer in the appeal pending before the Board of Patent Appeals and Interferences in the above-referenced case.

The circumstances necessitating this Petition are as follows. Appellants' Appeal Brief was filed September 6, 2001, appealing the final rejections of claims 2-9, 14-16, and 20-29 in the above-identified application. An Examiner's Answer was mailed November 27, 2001.

However, due to delays in the U.S. Postal System resulting from anthrax-related irradiation, the Examiner's Answer was not received by Appellants' Representatives until January 15, 2002.

Whereupon, on January 18, 2002, Appellants petitioned the Commissioner under 37 C.F.R. § 1.181 to reset the period for reply to the Examiner's Answer due to the mail delay. The Petition

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was granted on April 26, 2002, however, the two-month period to reply to the Examiner's Answer was reset to run from the actual receipt date of the Examiner's Answer, January 15, 2002, not the date of the decision on the Petition. Thus, the new period for reply granted by the Commissioner expired before the decision on the Petition was rendered on April 26, 2002.

Meanwhile, on June 4, 2002, in accordance with an earlier March 27, 2002 Order from the Administrator of the Board of Patent Appeals and Interferences remanding the case to the Examiner for, among other reasons, clarification of the status of the claims pending on appeal, Appellants' filed a Request for Remand to the Examiner on June 4, 2002 requesting a revised Examiner's Answer clarifying the status of the claims pending on appeal. On October 3, 2002, Appellants' representatives contacted the Administrator of the Board of Patent Appeals to inquire as to the status of the case, still anticipating a revised Examiner's Answer. The Administrator informed Appellants' representatives that the file was with the Examiner.

On October 22, 2002, rather than issuing a revised Examiner's Answer, the Examiner issued a communication clarifying for the record the claims on appeal. Appellants' representatives subsequently contacted the Administrator of the Board of Patent Appeals on November 5, 2002, the Administrator indicated that, according to PALM, the file was with a paralegal at the Board, but was unavailable to the Administrator due to an ongoing PTO file audit. At the Administrator's suggestion, Appellants' representatives called the Administrator's office on December 9, 2002 and again on January 9, 2003, but were unable to get through. On January 26, 2003, Appellants' representatives contacted the Administrator who advised that the best course of action, given the Examiner's action, to obtain entry of Appellants' Reply to the Examiner's Answer would be to submit Appellants' Reply Brief together with this Petition.

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Accordingly, submitted herewith is Appellants' Reply Brief under 37 C.F.R. §

1.193(B)(1). For the aforementioned reasons, Appellants respectfully request that this Reply Brief be entered in the interest of fairness and justice.

Please charge the requisite \$130.00 petition fee due under 37 C.F.R. § 1.17(h) to our Deposit Account No. 50-0310. The Commissioner is hereby authorized to charge any additional fees which may be necessary, or credit any overpayment, to our Deposit Account No. 50-0310.

Respectfully submitted,

MORGAN, LEWIS & BOCKIUS LLP

Dated: January 31, 2003

By: 

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COPY

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re Application of:Tomohiro KAWATA *et al.*

Application No.: 08/931,615

Filed: September 16, 1997

CPA Filed: May 24, 1999

For: SPEAKER UNIT

Group Art Unit: 2743

Examiner: Huyen Le

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Commissioner for Patents
Washington, D.C. 20231

Sir:

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FEB - 5 2003

APPELLANTS' REPLY BRIEF UNDER 37 C.F.R. § 1.193(b)(1)

This Reply Brief is in furtherance of Appellants' Appeal Brief filed September 6, 2001, appealing the final rejections of claims 2-9, 14-16, and 20-29 in the above-identified application. An Examiner's Answer was mailed November 27, 2001, although, due to delays in the U.S. Postal System, the Examiner's Answer was not received by Appellants' Representatives until January 15, 2002. Whereupon, on January 18, 2002, Appellants petitioned the Commissioner under 37 C.F.R. § 1.181 to reset the period for reply to the Examiner's Answer due to the mail delay. The Petition was granted on April 26, 2002, however, the two-month period to reply to the Examiner's Answer was reset to run from the actual receipt date of the Examiner's Answer, January 15, 2002, not the date of the decision on the Petition. Thus, the new period for reply granted by the Commissioner expired before the decision on the Petition was rendered.

Accordingly, submitted herewith is a Petition under 37 C.F.R. § 1.183 requesting entry of this Reply Brief in the interest of fairness and justice. Appellants respectfully request that this

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Reply Brief be entered. This Reply Brief responds to the arguments raised in the Examiner's Answer and is submitted in triplicate.

1. **SUMMARY OF THE EXAMINER'S ANSWER**

In the Examiner's Answer, claims 2-4, 6, 8-9, 15, 20, and 22-24 remain rejected under 35 U.S.C. § 103(a) as being unpatentable over *Sariti* (U.S. Patent No. 3,079,472) in view of *Nakamura* (U.S. Patent No. 4,969,196). Claims 5, 7, 14, 16, 21, and 25-29 remain rejected under 35 U.S.C. § 103(a) as being unpatentable over *Sariti* in view of *Nakamura* and further in view of *Lee et al.* (UK Patent Application GB 2 278 251) or *Numa* (Japanese Publication No. 55-118299).

2. **APPELLANTS' REPLY TO THE EXAMINER'S ANSWER**

- a. ***Sariti* Does Not Teach Or Suggest A Magnetic Circuit Formed In A Rectangular Shape Such That Each Of The Top Plate, The Plate-Shaped Magnet And The Back Plate Has A Width And A Length, Each Width Being Substantially Less Than Each Respective Length**

The Examiner's continued reliance on the *Sariti* reference as allegedly expressly teaching the claimed magnetic circuit "wherein each of the top plate, the plate-shaped magnet and the back plate has a width and a length, *each width being substantially less than each respective length*, thereby permitting installation of the speaker unit in a narrow space," is misplaced.¹

1. As discussed in detail in Appellants' Brief, the Examiner asserts that the language in the claims stating that "wherein each of the top plate, the plate-shaped magnet and the back plate has a width and a length, *each width being substantially less than each respective length*, thereby permitting installation of the speaker unit in a narrow space," is expressly taught by *Sariti*, not that it would have been obvious in view of *Sariti*. Nonetheless, Appellants submit that such claimed combinations are not only not expressly taught, but that they also would not have been obvious in view of *Sariti* or the other art of record for the reasons set forth in Appellants' Brief filed September 6, 2001.

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In the Examiner's Answer, the Examiner relies principally on two portions of *Sariti*: (1) the illustrations of the magnetic circuit in Figures 1-3; and (2) the text set forth at column 2, lines 56-58. See Examiner's Answer, page 3.

Considering first the illustrations shown in Figures 1-3 of *Sariti*, these illustrations clearly suggest forming a square rectangular magnetic circuit, or at most, a substantially square rectangular magnetic circuit. However, such a square rectangular magnetic circuit or a substantially square rectangular magnetic circuit is far different from Appellants' claimed invention, which is directed to, *inter alia*, a rectangular magnetic circuit "wherein each of the top plate, the plate-shaped magnet and the back plate has a width and a length, *each width being substantially less than each respective length*, thereby permitting installation of the speaker unit in a narrow space," *i.e.*, a magnetic circuit having sides that are substantially longer than they are wide. Hence, far from expressly teaching or rendering obvious the claimed invention, Figures 1-3 of *Sariti* in fact teach away from Appellants' claimed invention. Moreover, as is evident from Figures 1-3 of *Sariti*, the Examiner's contention that "[t]here is no disclosure in the *Sariti* reference that the sides of the housing 48 and each of front plate 12, magnet 33 and back plate 14 which are the same or substantially the same as argued [in Appellants Brief] on pages 11-12 and 15" is plainly incorrect, since these figures clearly depict square or substantially square magnetic circuit components. See Examiner's Answer, page 7.

Furthermore, examining the text set forth at column 2, lines 56-58, not in a vacuum, but in the context of all that is taught by *Sariti* as a whole, including the square rectangular (or substantially square rectangular) shape of the magnetic circuit components depicted in Figures 1-3, a skilled artisan would interpret the statement at column 2, lines 56-59 of *Sariti*, to indicate that the components of the magnetic circuit (*i.e.*, the magnet 33, front plate 12, and back plate

14) can be square rectangular, substantially square rectangular, or circular.² It is simply not the case that a skilled artisan would understand *Sariti*, viewed as a whole, to teach or suggest forming a magnetic circuit "wherein each of the top plate, the plate-shaped magnet and the back plate has a width and a length, *each width being substantially less than each respective length*, thereby permitting installation of the speaker unit in a narrow space." This is especially true in view of the square, or at most, substantially square rectangular shaped magnetic circuit depicted in Figures 1-3. Indeed, Figures 1-3 of *Sariti* would suggest forming structure that is far different from the claimed magnetic circuit "wherein each of the top plate, the plate-shaped magnet and the back plate has a width and a length, *each width being substantially less than each respective length*." Accordingly, at most, *Sariti*, viewed as a whole, would suggest forming a square rectangular, substantially square rectangular, or circular magnetic circuit.

The Examiner's contention that "*Sariti* does not restrict to the housing and the magnetic circuit in the only square shape as argued [by Appellants]" indicates that the Examiner misapprehends Appellants' position. See Examiner's Answer at p. 6. Appellants do not assert that *Sariti* should be construed as disclosing only a square shaped magnetic circuit. Rather, for the reasons discussed above, and in Appellants' Brief, Appellants assert that *Sariti*, viewed as a whole, suggests at most magnetic circuits that are circular, square rectangular, or substantially square rectangular in shape.

Significantly, *Sariti* does not draw a distinction between the square magnetic circuit structures 12, 14, and 33 shown in Figures 1-3 and other types of rectangles that are not squares. For example, *Sariti* at column 2, lines 56-58, does not mention squares, but only rectangles,

2. *Sariti* at column 2, lines 56-59, states: "The magnet 33 is formed in substantially the same shape as the front and back plates 12 and 14 which can be rectangular, circular or of any other desired shape."

circles and "any other desired shapes." Thus, in view of the plainly square magnetic circuit elements depicted in Figures 1-3 of *Sariti*, the term "rectangle," as used by *Sariti*, appears to be nearly synonymous with "square," and connotes a square rectangular shape or, at most, a substantially square rectangular shape. In a related manner, the phrase "or any other desired shape" in *Sariti* at column 3, line 59, is so general as to be devoid of meaning, and certainly would not provide any substantive guidance or suggestion that would lead a skilled artisan to form the particular unique rectangular magnetic circuit having "a width and a length, *each width being substantially less than each respective length*," as claimed.

Accordingly, the relied-upon portions of *Sariti* do not support the Examiner's contention that *Sariti* discloses Appellants' claimed combinations "wherein each of the top plate, the plate-shaped magnet and the back plate has a width and a length, each width being *substantially less than* each respective length, thereby permitting installation in a narrow space." Indeed, the housing 48 as depicted in *Sariti* Figures 1-3 is as different from Appellants' claimed combinations as it can possibly be, because rather than having one side that is substantially less than another (as required by Appellants' claims), the sides of housing 48, as depicted in Figures 1 and 2, are the same or, at most, substantially the same.

In the Examiner's Answer, the Examiner further contends that "[s]ince the magnetic circuit of *Sariti* is formed in a rectangular shape (column 2, lines 56-58), the width of each of the top plate, the magnet and the back plate is substantially less than the length of each respective length as claimed." *Id.* This is simply not correct. As discussed above, *Sariti* discloses magnetic circuits that are circular, square rectangular, or nearly-square rectangular in shape. Rectangles that are substantially square in shape do not have a width that is substantially less than each respective length.

From the foregoing, it is indisputable that *Sariti* does not expressly disclose or suggest any of the claimed combinations wherein each of the top plate, the plate-shaped magnet and the back plate has a width that is substantially less than its respective length. *Sariti* only suggests a circular, square rectangular, or at most, a substantially square rectangular magnetic circuit, and fails to teach or suggest a magnetic circuit having the *specific* dimensions and advantages associated with and provided for by the present invention.

b. *Sariti* Teaches Away From The Claimed Backplate Having A Rectangular Shape And Having An Integrally Formed Upright Pole On Its Center

Regarding the claimed "back plate having a rectangular shape and having an *integrally formed* upright pole on its center," on one hand the Examiner asserts that the upright pole in Figure 3 of *Sariti* is formed as a unit with the back plate of the magnetic circuit. See Examiner's Reply at p. 7. However, Figure 1 of *Sariti* clearly indicates that the pole piece 24 is formed *separately* from the back plate 14 and then pressed into the opening 16 in the back plate 24 (*i.e.*, the pole piece 24 and back plate 14 of *Sariti* are clearly depicted as two distinct parts). Accordingly, *Sariti* not only fails to teach or suggest the claimed back plate having an integrally formed upright pole, *Sariti* teaches away from this significant aspect of the invention, which may influence the performance or construction of the magnetic circuit, and hence the entire speaker unit.

On the other hand, the Examiner asserts that "constructing a formerly integral structure in various element [*sic*] involves only routine skill in the art." See Examiner's Answer p. 7. Such reasoning is inapposite, since the present invention is directed to constructing an integral structure which had been previously formed from separate elements. See, *e.g.*, Figure 1 of *Sariti* depicting pole piece 24 and back plate 14 as separate elements. Thus, the Examiner has not

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provided any rationale as to why an integrally formed upright pole would have been obvious, especially in view of the contrary teaching of a distinct pole piece 24 in *Sariti*. Accordingly, the rejections of claims 2-9, 14-16, 20-22, and 25-27 based on *Sariti* in view of *Nakamura* are incorrect and should be reversed.

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CONCLUSION

For the aforementioned reasons, and for the reasons set forth in Appellants' Brief dated September 6, 2001, Appellants respectfully submit that *Sariti, Nakamura, Lee et al.*; and *Numa*, whether taken singularly or in combination, do not teach or suggest the novel combinations of features recited in independent claims 4, 6, 20, 23, 25 and 28, and their dependent claims 2, 3, 5, 7-9, 14-16, 21, 22, 24, 26, 27, and 29.

In view of the foregoing, Appellants respectfully request the reversal of the Examiner's rejections and allowance of the pending claims. If there are any other fees due in connection with the filing of this Brief, please charge the fees to our Deposit Account No. 50-0310. If a fee is required for an extension of time under 37 C.F.R. § 1.136 not accounted for above, such an extension is requested and the fee should also be charged to our deposit account.

Respectfully submitted,

MORGAN, LEWIS & BOCKIUS LLP

Dated: January 31, 2003

By: 

Robert J. Hollingshead

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